

## **REMARKS**

### **Summary**

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46, and 48-71 are pending. Claims 1, 5, 28, 29, 45, and 56 are amended. No new matter has been introduced.

### **Response to Arguments**

Applicant thanks the Examiner for the indication that the prior arguments over Pennell, in view of Winbladh and Waskiewicz were persuasive. Applicant is however confused by the rejection of the same claims over the combination of Pennell and Winbladh for the same reasons previously presented. Applicant has addressed the rejections below, but requests withdrawal of the rejection for at least those reasons deemed persuasive by the Examiner in the current Office Action.

### **Rejections Under 35 USC 112**

Claims 1, 5, 28, 45, and 56 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Office Action indicates that the prior language regarding the simultaneous provision of email addresses is not supported by the specification. Applicant respectfully disagrees.

The term simultaneous means to be done at the same time. There is support for such a teaching as used in the claims, found in the Specification, for example, at page 10, lines 17-21, and in Figure 3a as well as elsewhere in the Specification. While the specific word "simultaneous" is not used in the Specification, Figure 3a and the related text provide for the generation of a collection of email addresses and the provision of that collection of addresses to the client computer. The description thus provides for the collection (grouping of email addresses) to be generated, and for that collection/grouping to be provided to the client computer. Thus, while the language differs, the email addresses that make up the collection (must be at least a first and second email address), are provided to the user computer at the same time as part of the collection of email addresses. Otherwise, the generation of the

collection of addresses and the provision of the collection of addresses to the client computer would not make sense.

Despite the argument presented above, Applicant has amended the claims to use language that is consistent with the language in the Specification. Applicant submits that the claims are clearly supported as presented, and thus requests reconsideration and withdrawal of the rejection.

### **Rejections Under 35 USC 103**

#### **Pennell and Winbladh**

Claims 1-6, 15-16, 20, 28-29, 41, 45-46, 56-57, 59-60, 62, 64-67, and 71 are rejected over US Patent No. 6,874,023 to Pennell et al. (Pennell) in view of US Patent No. 6,205,330 to Winbladh (Winbladh). Applicant respectfully traverses the rejection in light of the remarks below.

Claim 1 recites a method comprising a user computer providing a first email address received from an email service provider for use to register a user of the user computer with a first web site; the user computer providing a second email address received from the email service provider, separate and distinct from the first email address, for use to register said user with a second web site; wherein the first and second email addresses were provided together as a collection of email addresses to the user computer by the email service provider in advance of providing the first and second email addresses to the first and second web sites by the user computer.

Thus, according to claim 1, a user computer communicates with an email service provider to receive first and second separate and distinct email addresses provided together and in advance of the user computer in turn providing the first and second email addresses to the first and second web sites to register a user.

Pennell is cited for teaching the provision of email addresses for use to register a user with a first and second website. Notably, the system in Pennell self-generates individual email addresses as needed, and thus does not receive email addresses from an email service provider as recited in claim 1. In addition, Pennell

fails to teach the provision of the first and second email addresses to the user computer as a collection of email addresses.

Winbladh further does not teach the provision of first and second email addresses, as a collection of email addresses, that are “separate and distinct” as recited in claim 1.

Winbladh teaches the provision of a primary email address and at least one alias address. An alias address is associated with and dependent on the primary address, and thus the addresses are not “separate and distinct.” An alias address is translated into the primary address upon use or an access attempt. Thus, there is a clear required connection between the alias address and the primary address, as the alias is simply a stand-in for the primary address. Such a coupled relationship lends itself to provision jointly, whereas the provision of separate and distinct email addresses in a collection of email addresses, as recited in claim 1, is not taught or suggested.

The “separate and distinct” email addresses of claim 1 cannot be read as simply proxy or alias addresses, which would not provide the recited separateness or distinctiveness. Proxy and alias addresses are translated into the primary address upon receipt of a message, thus all messages received using any of such addresses are routed to the primary address. Clearly, the connected and dependent non-distinct relationship of such addresses is present.

The method of claim 1 thus provides for multiple separate and distinct email addresses to be provided, as a collection of email addresses, for use, respectively, to register with different websites. Thus, the user computer has access to the provided email addresses in advance of registering with the websites, thus potentially saving time and resources when the addresses are needed. These features are not provided by the cited references.

Therefore, Pennell and Winbladh fail to teach at least one element of claim 1, and thus claim 1 is patentable over the cited references.

Claims 28, 41, 45, 56, 59, 62, and 67 contain language similar to that of claim 1 and are therefore patentable over the cited references for at least the reasons discussed above with respect to claim 1.

In addition, independent claim 41 adds the concepts of obtaining email addresses in real time, and earmarking the email addresses for use with a first and second communication partner. The cited references fail to teach or suggest such features, and the Office Action is silent in this regard. As discussed above, Pennell describes the creation of email addresses when needed, but does not discuss obtaining separate and distinct email addresses in real time and earmarking the addresses for use with certain communication partners, as recited in claim 41.

Claim 2-6, 15-16, 20, 29, 46, 57, 60, 64-66, and 71 are dependent on claims 1, 28, 41, 45, 56, 59, 62, and 67 respectively incorporating their elements and are thus patentable over the cited references for at least the reasons discussed above.

Pennell, Winbladh, and Beyda

Claims 13-14, 24, 26-27, 31-32, 42-44, 48-49, 58, and 61 are rejected over Pennell in view of Winbladh in further view of US Patent No. 7,120,927 to Beyda et al. (Beyda). Applicant respectfully traverses the rejection in light of the remarks below.

Claims 13-14, 31-32, 42-44, 48-49, 58, and 61 are dependent directly or indirectly on claims 1, 28, 41, 45, 56, and 59 and thus are patentable over Pennell and Winbladh for at least the reasons discussed above. Beyda fails to overcome the deficiencies of Pennell and Winbladh discussed above and thus claims 13-14, 31-32, 42-44, 48-49, 58, and 61 are patentable over the cited references.

Claim 24 recites a method comprising an electronic device requesting and receiving for a user, a first email address from an email service provider at a first point in time subsequent to the user subscribing for email service with the email service provider; the electronic device employing the received first email address to facilitate communication between the user and a first communication partner or group of communication partners; the electronic device, prior to the first communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the first email address to facilitate communication with the first communication partner or group of communication partners; the electronic device

requesting and receiving for the user, a second email address, separate and distinct from said first email address, from the email service provider at a second point in time subsequent to the user subscribing for email service with the email service provider, the second point in time being a later point in time than the first point in time; the electronic device employing the received second email address to facilitate communication between the user and a second communication partner or group of communication partners; and the electronic device, prior to the second communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the second email address to facilitate communication with the second communication partner or group of communication partners.

Claim 24 recites a series of features that include (1) an electronic device requesting and receiving an email address for a user from an email service provider subsequent to the user subscribing for service with the email service provider; and (2) the electronic device using the address for communication and notifying the email service provider of such use prior to receiving a communication from the partner or group or partner.

Pennell is cited for teaching an electronic device requesting and receiving for a user from an email service provider a series of email addresses. Notably, the system in Pennell self-generates individual email addresses as needed, and thus does not receive email addresses from an email service provider as recited in claim 24. Winbladh discusses the creation of alias and proxy addresses, which are not separate and distinct addresses (as discussed in detail above) and which have nothing to do with the notification operations discussed above. The Office Action agrees, and thus cites Beyda.

Beyda is cited for teaching the notification operations of claim 24; however, Beyda does not teach (1) receiving email addresses from an email service provider, and (2) providing notice back to the email service provider when the email address is used (3) with particular communication partners. In Beyda, the CPU described provides a gating/relay function, but is not an email service provider as defined by the Specification and claims of the current application. Beyda supports this notion

and is clear that the CPU generates aliases to provide anonymity and then redirects or relays messages routed through the CPU, but passes those messages along to the users actual email account handled by the email service provider. Thus, the email service provider is essentially removed from such an operation. In claim 24, however, the email service provider is the one that provides the email addresses.

In addition to the difference described above, in claim 24, after use of the email address, the email service provider is notified of usage of the email address. Such notification of usage sent from the electronic device to the email service provider occurs before the communication partner initiates communication with the user. Thus, the email service provider is forewarned of the potential communication from the communication partner. This feature is not taught by Beyda. Rather, Beyda provides a mechanism to relay messages based on the particular alias address utilized. Such a function further distinguishes Beyda from claim 24 in that claim 24 provides for notice of usage of the email address for communication with a communication partner or group of partners. This notification is specific as to that particular usage. In Beyda, the system requires registration of communication partners to provide notice of proper incoming communications, but the system of claim 24 provides a notification operation from the initial user to ensure the messaging service is alerted to the propriety of an incoming message received from a particular source (communication partner).

Therefore, Pennell, Winbladh, and Beyda fail to teach at least one element of claim 24, and thus claim 24 is patentable over the cited references.

Claims 26 and 27 are dependent on claim 24 incorporating its elements and thus are patentable over the cited references for at least the reasons discussed above.

#### Pennell, Winbladh, and Gabber

Claims 12, 17-19, 33-38, 50-55, 63, and 68-70 are rejected over Pennell in view of Winbladh in further view of US Patent No. 6,591,291 to Gabber. Applicant respectfully traverses the rejection in light of the remarks below.

Claims 12, 17-19, 63, and 68-70 are dependent directly or indirectly on claims 1, 62, and 67 and thus are patentable over Pennell and Winbladh for at least the reasons discussed above. Gabber fails to overcome the deficiencies of Pennell and Winbladh discussed above and thus claims 12, 17-19, 63, and 68-70 are patentable over the cited references.

Further, with respect to claim 12, claim 12 provides for the user computer notifying the email service provider of the usage of the first and second email addresses, including addresses of the first and the second web site. In response thereto, the Office Action cites Gabber (Column 3, lines 35-41 and Column 8, lines 27-50). The cited sections of Gabber teach the mechanism for handling incoming messages using an alias address. The message may be blocked if matched to a "reject" list or translated into the source address if the receipt of the message is allowed. However, these teachings do not discuss the user computer notifying the email service provider of the use of the first and second email addresses, including the websites with which the email addresses have been employed. The method recited in claim 12 provides for communication of both usage of the email addresses and the particular websites with which the addresses have been utilized so that the email service provider may properly monitor the usage and/or properly handle the incoming messages. The described notification operation is however not provided by Gabber. Gabber provides for the use of the alias source address, which is the users address, but Gabber does not provide any teaching of notification to the email service provider of the addresses of the websites with which the user is communicating. Gabber is therefore clearly different from the recitation of claim 12.

Thus, claim 12 is patentable over the cited references for this additional reason. Claims 13 and 14 are dependent on claim 12 and thus are patentable over the cited references for at least the additional reasons described above with respect to claim 12.

Claim 33 recites a method comprising an email service provider receiving emails addressed to a first and a second email address of a user, the first and second email addresses being separate and distinct from each other and having been provided by the email service provider to an electronic device of the user for

the electronic device to facilitate respective communication between the user and a first and a second intended communication partner; and the email service provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses of the user.

Thus, claim 33 provides for the email service provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses.

Claim 33 is patentable over Pennell and Winbladh for the reasons discussed above. Furthermore, with respect to claim 33, the Office Action admits that Pennell and Winbladh fail to teach organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses. Thus, the Office Action cites Gabber.

Gabber does not provide any teaching of sorting received emails based on intended versus unintended communication partners of an email address. Gabber simply provides a separate email box for each email address but, within an email address box, there is no sorting of the messages based on intended versus unintended communication partners. In addition, Gabber provides a mechanism to sort emails based on the email address that is converted within the system from the base address. The converted email address may be utilized by a communication partner, and thus, based on the converted address, the system can sort the received messages. However, as multiple parties (intended and unintended) may use the same address, and such messages may be equally received and handled, the system clearly does not provide a mechanism to sort between intended and unintended communication partners of a single email address. In fact, Gabber indicates at Column 3, lines 30-34, that the system would permit receipt of messages from unintended partners (junk mail) and that the system could be used to trace the origin of the address and possibly determine how the unintended party obtained access to the email address. Such a system, however, does not provide a



mechanism to organize the incoming emails received based on the status of the communication partner, but rather provides a mechanism to determine after the messages have been received and sorted based on the address whether the email was authorized and, if not, to try to determine how the access was improperly granted.

The Office Action further points to Column 8 of Gabber for teaching the use of a "reject" alias source address for filtering received messages. Such a "reject" operation is not based on the party sending such a message (the web site, communication partner), but rather is based on the selection by the user to move that alias address to a list that is comprised of "reject" addresses. Thus, in Gabber, the user does not identify the websites the user is communicating with, but rather provides a mechanism for a received message having a user alias to be compared with a "reject" list to determine whether that message should be transmitted, regardless of the particular party sending the message. This differs clearly from the features of claim 33.

Therefore, Pennell, Winbladh, and Gabber fail to teach at least one element of claim 33, and thus claim 33 is patentable over the cited references.

Claims 35, 50, and 52 contain language similar to that discussed above with respect to claim 33. As claim 33 is patentable over Pennell, Winbladh, and Gabber, so are claims 35, 50, and 52 for at least the reasons discussed above with respect to claim 33.

Claims 34, 36-38, and 53-55 are dependent on claims 33, 35, 50, and 52 incorporating their elements respectively. Therefore, for at least the same reasons discussed above, claims 34, 36-38, and 53-55 are patentable over Pennell, Winbladh, and Gabber.

### Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-6, 12-20, 24, 26-29, 31-38, 41-46, and 48-71 are in condition for allowance and early issuance of a Notice of Allowance is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 796-2844. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
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